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U.S. Patent No. 7,019,027  
Atty. Docket No. U0037-299152

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

In re Application of : Joel Linden et al.  
Patent No. : 7,019,027 (Application No. 10/808,093)  
Issue Date : March 28, 2006  
Title : 2-AMINO-3-AROYL-4,5 ALKYLTHIOPHENES: AGONIST  
ALLOSTERIC ENHANCERS AT HUMAN A1 ADENOSINE  
RECEPTORS  
Filing Date : March 23, 2004  
Conf. No. : 4174

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Notification Of Error In Payment As A Small Entity Status and Request That Error Be  
Excused Under 37 CFR 1.28(c)**

Sir:

This paper is being filed pursuant to 37 CFR 1.28(c).

37 CFR 1.28(c) states:

*(c) How errors in small entity status are excused. If status as a small entity is established in good faith, and fees as a small entity are paid in good faith, in any application or patent, and it is later discovered that such status as a small entity was established in error, or that through error the Office was not notified of a loss of entitlement to small entity status as required by § 1.27(g)(2), the error will be excused upon: compliance with the separate submission and itemization requirements of paragraphs (c)(1) and (c)(2) of this section, and the deficiency payment requirement of paragraph (c)(2) of this section:*

*(1) Separate submission required for each application or patent. Any paper submitted under this paragraph must be limited to the deficiency payment (all fees paid in error), required by paragraph (c)(2) of this section, for one application or one patent. Where more than one application or patent is involved, separate submissions of deficiency*

*payments (e.g., checks) and itemizations are required for each application or patent. See § 1.4(b).*

*(2) Payment of deficiency owed. The deficiency owed, resulting from the previous erroneous payment of small entity fees, must be paid.*

*(i) Calculation of the deficiency owed. The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment. The total deficiency payment owed is the sum of the individual deficiency owed amounts for each fee amount previously erroneously paid as a small entity. Where a fee paid in error as a small entity was subject to a fee decrease between the time the fee was paid in error and the time the deficiency is paid in full, the deficiency owed is equal to the amount (previously) paid in error;*

*(ii) Itemization of the deficiency payment. An itemization of the total deficiency payment is required. The itemization must include the following information:*

*(A) Each particular type of fee that was erroneously paid as a small entity, (e.g., basic statutory filing fee, two-month extension of time fee) along with the current fee amount for a non-small entity;*

*(B) The small entity fee actually paid, and when. This will permit the Office to differentiate, for example, between two one-month extension of time fees erroneously paid as a small entity but on different dates;*

*(C) The deficiency owed amount (for each fee erroneously paid); and*

*(D) The total deficiency payment owed, which is the sum or total of the individual deficiency owed amounts set forth in paragraph (c)(2)(ii)(C) of this section.*

*(3) Failure to comply with requirements. If the requirements of paragraphs (c)(1) and (c)(2) of this section are not complied with, such failure will either: be treated as an authorization for the Office to process the deficiency payment and charge the processing fee set forth in § 1.17(i), or result in a requirement for compliance within a one-month non-extendable time period under § 1.136(a) to avoid the return of the fee deficiency paper, at the option of the Office.*

### **Facts**

When this application was filed on March 23, 2004, inventor Joel Linden was under an obligation to assign all of his rights in the application to the University of Virginia ("UVA") and

an assignment was subsequently recorded with the United States Patent and Trademark Office (“USPTO”) (Reel 015794, Frame 0278). On March 18, 2005, UVA assigned all of their rights in the application to the University of Virginia Patent Foundation (“UVAPF”) and an assignment was subsequently recorded with the USPTO (Reel 015794, Frame 0358). Based on the good faith belief that UVA qualified as a small entity when this application was filed, entitlement to small entity status was asserted for this application. The application was accorded small entity status by the USPTO, and small entity fees were paid throughout the prosecution of the application. The application issued as U.S. Patent No. 7,019,027 on March 28, 2006. A small entity issue fee was paid. In addition, a small entity 3.5 year maintenance fee was paid.

UVAPF has recently discovered that it did not qualify for small entity status as of August 4, 2008. In other words, small entity status was asserted in good faith, but changed after issue, unknown to the assignee.

### **Remarks**

The present application was filed on March 23, 2004. Based on the good faith belief that UVAPF qualified as a small entity throughout prosecution of the application, entitlement to small entity status was asserted for this application. However, as noted above, UVAPF has recently discovered that it did not qualify for small entity status as of August 4, 2008. The USPTO accorded small entity status to this application, and small entity fees have been paid throughout the prosecution of the application and the issue and maintenance of the resulting patent.

In accordance with 37 CFR 1.28(c), Applicants respectfully request that the erroneous payment of small entity fees as detailed below be excused.

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In accordance with 37 CFR 1.28(c)(2), Applicants are submitting a deficiency payment of \$490.00.

This deficiency payment was calculated, pursuant to 37 CFR 1.28(c)(2)(ii)(A-D), as follows:

Type of Fee Erroneously Paid	Current Fee Amount for Non- Small Entity	Small Entity Fee Paid	Date Paid	Deficiency Owed
3.5 Year Maintenance Fee	\$980.00	\$490.00	09/28/2009	\$490.00
<b>Total Deficiency Owed:</b>				<b>\$490.00</b>

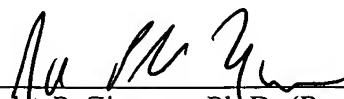
Pursuant to 37 CFR 1.33(b), a patent practitioner or recorder who is appointed in compliance with 37 CFR 1.32(b) has signed this document.

Applicants believe that no additional fee other than the fee discussed above is necessary, however, should a fee be deemed to be necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. 11-0855.

Should the Examiner have any questions relating to the instant application, the Examiner is invited to telephone the undersigned at (704) 338-5019 to discuss any issues.

Respectfully submitted,

Date: Aug. 13, 2010

  
John P. Zimmer, Ph.D. (Reg. No. 64,750)

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